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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,950	07/30/2003	Ronald C. Elliot	ECC-02100	1764

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EXAMINER
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GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/631,950	<b>Applicant(s)</b> ELLIOT, RONALD C.	
	<b>Examiner</b> Bryon P. Gehman	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3728

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5-6 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al. (5,791,534). Disclosed is a paint storage apparatus comprising a container or cup (22) divided into a plurality of compartments (32, 34, 40) and a lid (24) having a plurality of orifices (at 16, 18 and 20), the orifices aligned over the compartments with one of the orifices over each of the compartments.

As to claims 5 and 11, the container and lid are substantially angular.

As to claim 6, the lid (24) is configured to mate with outer walls of the container.

As to claim 12, the container is uniformly formed of a homogeneous material (polymer resin, plastic).

3. Claims 37, 40-43 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Crilly (5,746,346). Disclosed is a divided paint storage apparatus (Figures 5, 6 or 7) comprising interior walls (inside surfaces of 54) and one or more dividers (70-75) configured to separate the apparatus into a plurality of separate chambers to store paint.

As to claims 40-43 and 45, Crilly discloses various shapes of the paint storage apparatus.

Art Unit: 3728

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al.. The shape of the container and lid is not seen to define any new and unexpected result from its selection. Applicant indicates the shapes to be matters of design choice. The exact polymer resin (polypropylene) chosen would appear to be a matter of design choice.

6. Claims 1-12, 16-22, 24-28, 32-33, 37 and 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crilly (5,746,346) in view of Davis et al.. Crilly discloses a paint storage apparatus comprising a container or cup divided into a plurality of compartments (10-11 and 13). Davis et al. discloses a paint storage apparatus with a lid having a plurality of orifices and groove means (rim 28). To modify the Crilly paint storage apparatus employing a lid having a plurality of orifices aligned over each compartment would have been obvious in order to allow individual access to each compartment through the lid, as suggested by Davis et al..

As to claims 2-5, 7-11, 17-21 and 40-43, the exact shape of the apparatus would have been a matter of design choice, the shape of the apparatus not providing any new and unexpected result.

As to claims 12, 24-26 and 45-48, the container of Davis et al. is uniformly formed of a homogeneous material (polymer resin, plastic). The exact polymer resin (polypropylene) chosen would appear to be a matter of design choice.

As to claims 28 and 49, Davis et al. disclose tapered orifices.

7. Claims 13, 31, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al., alone or in combination with Crilly, and further in view of Hawkins (5,490,608). Hawkins discloses a hinged lid (18 or 22) provided with a tab to conventionally facilitate opening the lid. To modify the container of Davis et al. employing a lid with a tab as taught by Hawkins would have been obvious in order to seal the paint within the compartments and facilitate opening of the lid.

8. Claims 14, 29-30 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 6, 16 and 44 above, and further in view of Hawkins (5,490,608). Hawkins discloses a hinged lid (18 or 22) provided with a tab to conventionally facilitate opening the lid. To modify the prior art further employing a lid with a tab as taught by Hawkins would have been obvious in order to seal the paint within the compartments and facilitate opening of the lid.

9. Claims 15, 23 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 6 above, and further in view of Eckhaus (2,016,488). Eckhaus discloses grooves engaging a lid to a container. To modify the

prior art employing grooves to engage a lid to a container would have been obvious in view of Eckhaus, in order to secure the lid to the container in a sealed manner.

10. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al.. To employ thermoforming to provide the molded container of Davis et al. would not appear to distinguish any new and unobvious result, as official notice is taken that thermoforming molded containers was well known in the art at the time applicant's device was derived.

11. Claims 6-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 7-8 of claim 6, "the plurality of walls" lacks antecedent basis or consistency with line 3.

12. Applicant's arguments filed September 23, 2004 have been fully considered but they are not persuasive. In response to applicant's numerous arguments that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (e.g., the structure of the claim 1 argued but not set forth in the claims, such as paint arranged in the compartments or types of paint or the compartments being sealed or the mere intended use of the compartments) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re*

*Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A paint brush coated with paint renders a compartment it is in a "paint compartment". In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The combination of Crilly with Davis et al. is maintained to be proper.

13. This action is made non-final in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4555.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3728

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Bryon P. Gehman". The signature is fluid and cursive, with the first name "Bryon" being more prominent than the last name "Gehman".

Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG